



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Application No.:	10/753,453	Examiner:	CHAPMAN, Jeanette
Filing Date:	January 9, 2004	Art Unit:	3635
First Inventor:	Bernard Paul Joseph Thiers	Customer No.:	23364
Attorney No.:	THIE3009/JEK/JJC	Confirm. No.:	8707

For: FLOORING COVERING, FLOOR PANEL AND SET OF FLOOR PANELS FOR FORMING SUCH FLOOR COVERING, AND METHODS FOR THE PACKAGING AND MANUFACTURING OF SUCH FLOOR PANELS

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

This is an appeal brief filed pursuant to the appellant's appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 24-33 in the above-identified application.

08/21/2007 MAHME1 00000023 10753453
02 FC:1402

500.00 0P

I. REAL PARTY OF INTEREST

The real party of interest is the assignee of record: Flooring Industries, Ltd.
(Dublin, Ireland).

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 24-36 are currently pending in the instant application. Claims 1-23 are cancelled. Claim 24 is an independent claim and claims 25-36 depend from claim 24.

IV. STATUS OF AMENDMENTS

There are no outstanding amendments to the claims. The most recent amendment to claim 24 appears to have been entered and considered by the examiner in the Office action dated May 25, 2007.

It will be noted that it appears that claims 34-36, which were submitted with claims 24-33 in the preliminary amendment dated September 30, 2005, have not been acknowledged as being entered in the application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

For the purposes of appeal, only the rejection of independent claim 24 is appealed. It will be assumed that claims 25-36 will rise or fall based on the determination of the patentability of claim 24.

Claim 24 recites a set of floor panels (2) configured for forming one and a same floor covering (1) (Fig. 1; page 11, lines 9-19). The set of floor panels (2) include two types of individual floor panels: a first type of floor panels defining a substantially common first length (L1) that is different from a second common length (L2) defined by a second type of floor panels (Figs. 5 and 6; page 12, lines 21-32).

Each floor panel (2) is defined as a generally rectangular, strip shaped hard floor panel having a layered structure (15, 16, 17) and mechanical coupling parts (7, 8, 9, 10) defined along each of four edges (3, 4, 5, 6) of the panel (Figs. 1-3; page 11, lines 24-32; page 13, lines 1-13).

At least two of the coupling parts (7, 8, 9, 10) are located on the opposed edges (3, 4, 5, 6) of each of the panels (2), and are arranged for locking in both vertical and horizontal directions (Figs. 1-3; page 11, line 24 through page 12, line 13). The coupling parts of the first type of floor panels (defined by L1) and the second type of floor panels (defined by L2) cooperate with one another for forming the floor covering (page 11, lines 24-32; Figs. 1-6).

The layered structure of each of the panels includes at least one decorative paper layer (16) soaked in resin (page 13, lines 1-13; Figs. 2 and 3).

The set of individual floor panels (2) is provided in a single package (23) (page 15, line 30 through page 17, line 17; Figs. 8 and 9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (herein referred to as "*Meckstroth*") in view of U.S. patent 6,863,768 (herein referred to as "*Haffner*"), U.S. patent 4,479,333 (herein referred to as "*Hendrich*"), and U.S. patent 6,256,952 (herein referred to as "*Fahy*").

VII. ARGUMENT

A. Overview

It is submitted that the proposed combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fails to render the pending claims *prima facie* obvious since these references, taken as a whole or in combination, fail to teach every feature required by the pending claims. More specifically, one having skill in the art would not be motivated by the proposed combination to devise the set of individual and differently sized decorative floor panels, and placed in a single package for forming one and the same floor covering according to the pending claims. Accordingly, withdrawal of the rejection is respectfully requested.

B. Pertinent Law on Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.

The scope and content of the prior art, and the level of ordinary skill in the art may be evidenced by the prior art references. *In re GPAC Inc.*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *see also In re Oelrich*, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978).

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d, 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In order to establish a *prima facie* case of obviousness, the examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *See Fine*, 837 F.2d at 1074, 5 USPQ2d at 1598.

Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’.... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

C. Reasons Why Claim 24 is Patentable Over the Proposed Combination of *Meckstroth*, *Haffner*, *Fahy* and *Hendrich*

Before proceeding on the scope and content of the prior art, and the differences of the prior art over the limitations required by the pending claims, the appellant establishes that the level of one of ordinary skill in the art is manifest by the teachings at the time of the invention of at least the cited references used in rejecting the pending claims.

Now in turning to the cited prior art references used for rejecting the pending claims, it is first asserted that one having skill in the art of installing floor panels would readily recognize that a floor covering naturally “covers” structural panels or similar structural building members, and in no manner functions as a structural element itself. The idea that a floor covering panel is not a “structural” panel of the type described by *Meckstroth* will be elucidated when comparing the construction and thickness of the structural panels of *Meckstroth* to the floor covering panels of *Haffner*.

Contrary to the rejection in the action, *Meckstroth* does not disclose or suggest a “set” of decorative floor panels for composing a floor “covering” having a decorative layer. Instead, it is clear from *Meckstroth* that it relates to “structural”

panels for building components (col. 2, lines 14-18). As explained by *Meckstroth*, the structural panels are for use in buildings such as modular dwelling units, housing sections, or building panels which are provided for forming connections between modules (col. 1, lines 11-15). One skilled in the art would readily recognize that using the structural panel of *Meckstroth* would be unsatisfactory as a floor covering panel.

Pending claim 24 specifically recites a “set” of floor panels for forming “one and a same” floor covering, and that these floor panels are individual. It follows from the plain language of this claim that while these panels are provided in an individual manner, they are connected to one another in the form of defining the “set” that forms the “covering” for a floor. In other words, by using the term “set,” the panels are not merely randomly packaged, but they are ordered in a certain manner to form one and the same floor covering.

Structurally, the floor panels of claim 24 are specifically recited as being “strip shaped,” and the skilled artisan would clearly understand, as evidenced by the embodiments of *Haffner* and described more fully below, that the structural panels of *Meckstroth* are not strip shaped and hence could not be arranged as a set for forming one and the same floor covering.

In comparison to the floor panels of the pending claims, the structural panel of *Meckstroth* would be akin to using a brick wall as a floor covering. While a structural panel or brick wall could be used as a floor covering, one skilled in the art would understand that such robust and thick construction items would be unsatisfactory, undesirable and burdensome for covering an already existing floor which is already presumably formed from some sort of structural element of the type described by *Meckstroth*. In short, one skilled in the art would readily recognize that it makes no sense to redundantly cover a structural panel over another existing structural panel, as suggested in the rejection.

Turning to its structure, *Meckstroth* requires that each structural panel includes a vertical frame member (12), an outer skin formed by a sheet of rough-sawn exterior plywood scored at spaced intervals to receive horizontally spaced battens (14), an inner skin formed of a sheet of dry wall (16), and a polyurethane foam core filling the space between the sheet (18) (col. 2, lines 21-36). A tubular bracket (30) is required to connect adjacent structural panels.

Meckstroth particularly states that the frame member is preferably formed from a standard two-by-four (4-5 cm X 9-10 cm) or similarly sized structure (col. 4, lines 14-21). Taking into account that the plywood sheet and the dry wall sheet each most likely has a thickness of at least 1 cm, and the aforementioned thickness of the frame members, it is clear from the construction of the structural panels of *Meckstroth* that the total thickness of such panels would be on the order of at least 12 cm.

Obviously, from the robust and robust construction of the structural panels of *Meckstroth*, the skilled artisan would understand that in no way would the panels of *Meckstroth* be suitable for forming a floor covering. The fact that the structural panels of *Meckstroth* could be used or modified with the teachings of *Haffner* does not render the pending claims obvious unless these references suggest the desirability of the combination. As will be pointed out below, there is no desirability for the proposed combination of *Meckstroth* and *Haffner* (and further *Hendrich* and *Fahy*).

While *Haffner* relates to laminate flooring, it does not relate to structural panels. There is no suggestion or desirability in *Meckstroth*, *Haffner*, *Hendrich*, and *Fahy*, or sufficient rationale articulated in the office action that shows how one skilled in the art would be motivated to modify the structural panel of *Meckstroth* with a decorative layer of the type taught by *Haffner*. Certainly, it is well understood that the teachings of the prior art must be considered as a whole, and it is plain in view of the disclosures of *Meckstroth* and *Haffner* that there is no desirability to include a decorative layer on the structural panel of *Meckstroth*.

In response to the appellant's previous remarks, the rejection argues that the construction of the structural panel according to *Meckstroth* shown in figure 1 resembles the construction of the floor panel of *Haffner* shown in figure 2. While it is correct to observe that the construction of the structural panel of *Meckstroth* bears a resemblance to the floor panel of *Haffner*, the depiction of the floor panel of *Haffner* is found to be misleading in its actual size and thus application.

As stated in MPEP 2125, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). As discussed below, it is submitted that the skilled artisan would readily understand by reading the specifications of *Meckstroth* and *Haffner* in combination with the drawings, that the panels are structurally substantially different from one another.

In observing the drawings of *Meckstroth* and *Haffner*, the depiction of the structural panel of *Meckstroth* in figure 1 appears to proportionally depict the features of the structural panel whereas the depiction of the floor covering panel in figure 2 of *Haffner* is schematic and merely exemplary. Keeping in mind the probable thickness of the structural panel of *Meckstroth*, it is clear in observing *Haffner* that the size of the floor panel taught therein is substantially different in size and application from the structural panels required by *Meckstroth*. Namely, the floor panel of *Haffner* is much thinner than the structural panel of *Meckstroth*, and as such is directed to a considerably different application from being a structural panel.

The thin structure of the floor panel of *Haffner* is actually suited for covering a structural panel of *Meckstroth* or other similar structural building member known to those skilled in the art. As strongly evidenced by the floor panel dimensions, *Haffner* teaches that the floor panel has a thickness of about 0.610 to about 0.813 cm (col. 11, lines 35-36). Of course, one skilled in the art would readily recognize the desirability in providing a substantially thin panel for a floor covering since it would be undesirable to provide a much thicker panel thereby resulting in a considerable reduction in headspace. In other words, one skilled in the art understands that a floor

covering is not substantially to impact the height of a room in which it is installed, as would be the case if the modified structural panel of *Meckstroth* were used.

Further, the floor panel of *Haffner* comprises a stable substrate as a core as opposed to the foam core taught by *Meckstroth*. Further, the layers (14, 16) are a decorative surface and a backing layer, respectively. As explained in *Haffner*, the decorative layer (14) is a conventional surface layer commonly used in flooring panels, and preferably includes three resin impregnated paper layers (28, 30, 32) (*see generally* col. 5). Likewise, the backing layer (16) includes some paper layers. There is no frame member of the type taught by *Meckstroth* in the floor panel of *Haffner*.

One skilled in the art would readily understand that the paper layers of *Haffner* are not structurally strong and must be applied to a stable core. Moreover, one skilled in the art would further appreciate that a stable core is distinguished from a foam core which is not considered to be sufficiently stable to allow for the lamination of paper layers thereon and to provide sufficient structure to withstand walking thereover.

In observing the paper layers used to form the decorative layer (14) and the backing layer (16), one skilled in the art would readily recognize that these paper layers are known to have a thickness in a range of 0.2 to 0.3 millimeters. The skilled artisan would then understand from figure 2 of *Haffner* that these depicted layers are not as thick as they are portrayed in the figure, and as such the skilled artisan would readily recognize that the structural panel of *Meckstroth* is provided for a completely different application than the floor covering panels of *Haffner*.

It is not entirely clear where or how the rejection proposes to apply the decorative layer of *Haffner* onto the structural panel of *Meckstroth*. Certainly, one skilled in the art would be required to account for the lack of structural strength of the paper layers of *Haffner* if they were to replace one of the inner and outer skins of *Meckstroth*, and particularly would require some motivation to cover the inner or outer skins with the paper layers of *Haffner* since it presumed that they are already sufficiently durable to resist chemical, heat and abrasion resistance.

When considering the different purpose that the structural panel of *Meckstroth* serves over the floor covering panel of *Haffner*, the rationale for providing the decorative layer of *Haffner* on the structural panel of *Meckstroth* is nowhere to be found among the teachings of *Meckstroth* and *Haffner*. Instead, the basis provided in the action (e.g., providing the structural panel with an attractive appearance, and chemical, heat, and abrasion resistance) is based merely on speculation without any foundation in the prior art.

As such, it is submitted that there is simply no mention of the desirability of modifying the structural panel in *Meckstroth*, or even a hint of directly applying the decorative layer of *Haffner* to anything but a stable core.

It is implied in the action that *Meckstroth* does not teach a structural panel wherein mechanical coupling parts are defined along each of the four edges of the panel, and such coupling parts are arranged to lock with one another in vertical and horizontal directions. In order to make up for this shortcoming, *Fahy* is apparently used as a prior art teaching disclosing floor panels of different lengths, and panels having mechanical coupling parts located on edges of the floor panels for mating with other floor panels.

From the action, it is not understood why the skilled artisan would understand from *Fahy* to use the mechanical coupling parts thereof on the structural panels of *Meckstroth*, in particular coupling parts that are arranged for locking in both vertical and horizontal directions, as required by the pending claims. *Fahy* describes a “raised” flooring panel whereas *Meckstroth* describes structural panels for forming walls, floors and the like. The skilled artisan, with the knowledge exemplified by the description of floor panels for covering a floor in *Haffner*, would not be motivated by *Fahy* and *Meckstroth* to make a set of floor panels arranged for forming a floor covering in which each have mechanical coupling parts of the type described by the claims because *Fahy* and *Meckstroth* relate to panels that are different from floor covering panels.

Next, while *Meckstroth* teaches that the structural panels may be provided in different widths or lengths, there is no suggestion by *Meckstroth* of taking the unobvious step of the pending claims to provide a set of floor panels having different sizes in a single package, as required by the pending claims. *Meckstroth* merely indicates that the panels may be prefabricated in different widths or lengths (col. 2, lines 50-55). There is no indication that these differently sized panels may be provided in a set (for forming one and the same floor covering) that includes panels of different dimensions.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the rejection (col. 2, lines 50-55) merely conveys that panels of different dimensions may be produced according to different applications such as “depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels.” From this passage, without the benefit of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panels may have a certain width that is different from the roof panels.

Contrary to the assertion in the rejection, claim 24 clearly requires that the differently sized panels be provided in a set for forming one and the same flooring covering, and that the set of panels is put together in a single package. It is submitted that *Meckstroth* clearly does not advise the skilled artisan of doing anything more than merely providing differently sized structural panels, and does not motivate the skilled artisan to take the unobvious step of packaging the set of panels in a single package, as mandated by the pending claims.

The rejection also appears to indicate that *Fahy* teaches providing floor panels of different sizes in a set. The appellant respectfully disagrees. While *Fahy* discusses the fact that the floor panels may be in different sizes (col. 1, lines 40-46; col. 5, lines 23-34), there is nothing in *Fahy* that would motivate one skilled in the art to provide such differently sized floor panels in a set for one and the same floor covering.

Instead, *Fahy* just discusses the fact that floor panels have different sizes and the problems associated with the differently sized panels, and does not describe the unobvious step of providing a set of floor panels in a single package.

Thus, *Fahy* does not make up for the shortcomings of *Meckstroth*, and hence none of the references cited in the rejection instruct the skilled artisan to take the unobvious step of providing a set of panels for forming one and the same floor covering with differently sized panels in a single package.

Lastly, it is submitted that the addition of *Hendrich* with the teachings of *Meckstroth*, *Haffner* and *Fahy*, fails to convey to one skilled in the art the feature of the pending claims wherein the set of separate floor panels is provided in a single package. While *Hendrich* appears to be used in the combination as a teaching that it would be obvious to “package building structures for transportation to a building site,” it is submitted that such a teaching does not amount to a prior art teaching of the express limitation in the pending claims requiring that the set of floor panels is provided in a “single package.”

It will be noted that the appellant’s specification clearly defines “package” as being one and the same “packaging box” or container for storing and transporting the floor panels in accordance with the invention (see page 8, lines 4-15).

In response to the appellant’s prior arguments, the rejection appears to consider the structure taught by *Hendrich* as being irrelevant, and instead *Hendrich* is simply provided to demonstrate that it is known in the art to package items in kits in the building industry. While *Hendrich* may indeed be merely provided to show that it is known to package items in kits or sets in the building industry, the rejection provides no evidence other than conclusory statements to demonstrate how one skilled in the art would adopt this teaching of *Hendrich* in grouping with the proposed combination of *Meckstroth* and *Haffner*.

Turning specifically to *Hendrich*, this prior art document relates to complex folding building structural elements hingedly connected to one another to form

building modules (col. 2, lines 11-17). Such building modules of *Hendrich* include structural floor elements hingedly connected to roof elements, as aptly portrayed in Fig. 1. It is submitted that hingedly connected structures and floor panels having decorative layers are inapposite, and, as such, one skilled in the art would neither turn to the teachings of *Hendrich* nor find any motivation from *Hendrich* to provide decorative floor panels in a single “package.”

While it is true that *Hendrich* teaches transporting the modules by a truck or a rail car, there is no teaching of placing such modules in a “single” package, as taught and defined by the appellant’s specification. Furthermore, due to the sheer size of the structural building modules of *Hendrich*, as evidenced by the hingedly connected roof and floor elements of Fig. 1 of *Hendrich* and the description that such panels must be transported by rail or truck (col. 3, 14-17), it is clear that one skilled in the art would easily recognize that such modules cannot be provided in a single package of the type that is readily known to one skilled in the art of decorative floor panels.

It appears that the limitation that the panels are “individual” and hence individually stored in a single package is overlooked with respect to *Hendrich*. Indeed, the limitation of “individual” and differently sized panels in a single package is substantially different from the teachings of *Hendrich* which require that the panels of the module are connected to one another. The limitation of the pending claims is not a trivial variation over the description of *Hendrich*; it is instead one of the essential features of the claims which adds to the unobvious results of providing panels of at least two different sizes when installing a decorative floor covering, and mitigating the need for the installer to purchase an excess amount of panels of a certain size when few are required (specification on page 2, line 28 through page 3, line 5).

The appellant’s prior remarks are meant to demonstrate that one skilled in the art would not be motivated to combine the teachings of *Hendrich* with those of *Meckstroth* and *Haffner*. While the appellant understands that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into

the structure of the primary reference, the appellant also understands that the test for obviousness is whether the combined teachings of the references, when considered as a whole, would have suggested to one of ordinary skill the claimed invention. The appellant has shown in the prior remarks that upon considering the entirety of the teachings of *Hendrich*, one skilled in the art would not be motivated to combine the teachings of *Hendrich* with those of *Meckstroth*, *Haffner* and *Fahy*.

Simply put in view of the express limitations of claim 24, there is no teaching of providing such individual modules and placing such individual modules in a “single” package or packages of any type. Furthermore, due to the sheer size of the structural building modules of *Hendrich*, as evidenced by the hingedly connected roof and floor elements and the description that such panels must be transported by rail or truck (col. 3, 14-17), it is clear that one skilled in the art would not understand from *Hendrich* the concept of providing sets of differently sized floor covering panels in a single package.

Despite the rejection’s response to the appellant’s prior remarks, the action still provides no grounds as to how one skilled in the art would be motivated to combine *Hendrich* with the teachings of *Meckstroth*, *Haffner* and *Fahy*. Instead, there is a conclusory statement that one skilled in the art would have “appreciated packaging the materials in any convenient, efficient and low cost manner.” This statement is rather speculative in nature, and lacks any articulated reasoning from the references themselves with some rational underpinning to support the conclusion of legal obviousness.

As is well understood, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some objective reason to combine the references through a teaching, suggestion or motivation to do so either explicitly or implicitly in the references themselves, or in the knowledge of one of ordinary skill in the art. It is respectfully submitted that the one having skill in the art would not be motivated to combine *Meckstroth*, *Haffner*,

Fahy and *Hendrich*, whether it be through the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art.

The appellant submits that in view of the foregoing remarks, one skilled in the art would not be motivated to combine the teachings of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* to arrive at the set of floor panels required by the pending claims. The recited set of floor panels is an unobvious step over the cited prior art, and possesses advantages that were not appreciated by those skilled in the art at the time of the present invention was made.

Meckstroth, *Haffner*, *Hendrich* and *Fahy* each seek to solve different problems, and therefore there is no motivation to combine these reference in the nature of the problem in which the references seek to solve. Specifically, *Meckstroth* is directed to providing an inexpensive and simple manner for joining adjacent structural panels with a joint device that is separate from the structural panels themselves (col. 1, lines 43-75). On the other hand, *Haffner* is directed to providing a method for forming an edge profile of a decorative laminate panel that is water resistant (col. 2, line 36 through col. 4, line 10). Further, *Hendrich* is directed to solving the problem of hingedly connected building modules (col. 2, lines 11-49). As for *Fahy*, it provides coupling parts on sides of a raised floor panel. None of these references seek to solve the problem of providing "individual" floor covering panels of different lengths, and each having coupling parts to couple to one another in a "single" package for forming the floor covering.

When considering the pending claims of the application, it is widely understood that secondary considerations of non-obviousness should be given attention. Indeed, the claims of the pending application present a specific manner for packaging a certain type of panels in the form of decorative floor covering panels that is not taught by the combination of prior art references, or was understood by the skilled artisan at the time of the invention. The manner for packaging the floor panels of the instant application departs from the traditional manner of packaging decorative

floor panels of a same size in a single package. This results in the need for manufacturers to sell different packages of individual dimensions.

The pending claims recite a manner that provides a mixture of different sized decorative floor panels in a single package. This provides significant benefits which were not foreseen by the prior art, including the proposed combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy*.

As detailed in the specification, which was filed under oath or declaration by the inventor, evidence of these benefits includes providing panels of at least two different sizes when installing a decorative floor covering, and mitigating the need for the installer to purchase an excess amount of panels of a certain size when few are required (specification on page 2, line 28 through page 3, line 5). It flows from this benefit that there is a sufficient mixture of sized panels for the installer (specification on page 8, lines 4-15).

Another benefit is that the manner of providing the differently sized decorative panels in the sets required by the claims is that a distributor need only stock a few types of floor panels without much concern as to the sizes of the panels. A drawback in known methods of packaging decorative floor panels is that since the floor panels are sold in different lengths in different boxes, some sizes are sold in higher amounts than others. Since it is difficult for the distributor to anticipate the sales of different sizes, a mixture of sizes can be provided in a single package so as to reduce the overall stock of panels (specification on page 8, lines 17-26).

This evidence provided in the specification exemplifies how the invention sought to overcome a uniquely challenging problem, and provided an unobvious solution, in view of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy*, over the prior art.

In the view of these observations, it is submitted that the proposed combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover,

there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed combination to devise the set of packaged, individual, and differently sized decorative floor panels for forming one and the same floor covering according to the pending claims. Accordingly, withdrawal of the rejection is respectfully requested.

VIII. Conclusion

For the reasons set forth above, independent claim 24 of the pending application defines subject matter that is not obvious within the meaning of 35 U.S.C. § 103(a) by *Meckstroth, Haffner, Fahy and Hendrich*.

Reversal of the rejection of claim 24, and allowance of claims 24-36 is respectfully requested.

The Office is authorized to charge any additional fees associated with this communication Deposit Account No. 02-0200.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500

Respectfully submitted, .

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

Date: August 20, 2007

JUSTIN J. CASSELL
Attorney for Appellant
Registration No. 46,205

IX. CLAIMS APPENDIX

1-23: (Cancelled)

24: A set of floor panels configured for forming one and a same floor covering, the set of floor panels comprising at least two types of individual floor panels, a first type of floor panels defining a substantially common first length that is different from a second common length defined by a second type of floor panels, the types of the floor panels being defined by their corresponding lengths, each floor panel defining a generally rectangular, strip shaped hard floor panel having a layered structure and mechanical coupling parts defined along each of four edges of the panel;

wherein at least two of the coupling parts located on opposed edges of each of the panels are arranged for locking in both vertical and horizontal directions;

wherein the coupling parts of the first type of floor panels and the second type of floor panels cooperate with one another for forming the floor covering;

wherein the layered structure of each of the panels includes at least one decorative paper layer soaked in resin;

wherein the set of individual floor panels is provided in a single package.

25: The set of floor panels according to claim 24, wherein the printed decorative layer portrays a wood or parquet pattern.

26: The set of floor panels according to claim 24, wherein the decorative layer of each of the floor panels is defined as a single continuous wood pattern over at least one entire surface of the respective floor panel.

27: The set of floor panels according to claim 24, wherein the floor panels of the set have the same width.

28: The set of floor panels according to claim 24, wherein said set includes floor panels having different widths.

29: The set of floor panels according to claim 24, comprising a third type of floor panels having a third common length.

30: The set of floor panels according to claim 29, consisting of three types of floor panels, each type having a different common length.

31: The set of floor panels according to claim 30, wherein the first length substantially spans an entire length of the package, the second length and the third length have a combined length generally equaling in length to the first length.

32: The set of floor panels according to claim 24, wherein the first length defines a longest length, the quantity of the floor panels belonging to the first type outnumber the quantity of floor panels for each other type.

33: The set of floor panels according to claim 24, wherein the floor panels of a longest length have a length that is at least eight times their width.

34: The set of floor panels according to claim 24, wherein the single package includes a box arranged to accommodate the set of floor panels in a stacked configuration, the floor panels are arranged in the box in a manner preventing the floor panels from tilting from the stacked configuration.

35: The set of floor panels according to claim 24, comprising three types of floor panels each having a different common length including a third type of floor panels having a third common length, wherein the first length substantially spans an entire length of the package, the second length and the third length have a combined length generally equaling in length to the first length;

wherein a floor panel of the second type and a floor panel of the third type are arranged along a same level in the package thereby combining to span the entire length of the package.

36: The set of floor panels according to claim 24, wherein all four coupling parts of each of the floor panels are arranged for locking in both horizontal and vertical directions with other floor panels.

X. EVIDENCE APPENDIX

There are no copies of evidence entered and relied upon in this appeal
of the pending application.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings or decisions rendered by a court or the Board of Appeals in any proceeding identified in the related appeals and interferences section in the pending application